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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,555	12/28/2000	Masahiro Ando	G5030.0023 /P023	5633

24998 7590 10/18/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L Street, NW  
Washington, DC 20037

EXAMINER
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NAJARIAN, LENA

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/749,555		ANDO ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Lena Najarian		3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 8/4/05. Claims 1-19 remain pending. Claims 20-25 were previously withdrawn.

### ***Oath/Declaration***

2. The objection to the oath/declaration is hereby withdrawn due to remarks made in the amendment filed 8/4/05.

### ***Drawings***

3. The objection to the drawings is hereby withdrawn due to the amendment filed 8/4/05.

### ***Specification***

4. The objection to the abstract is hereby withdrawn due to the amendment filed 8/4/05.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 9, 11-12, 14-15, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heikkila et al. (US 6,428,476 B1) in view of Sham et al. (5,891,042).

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(A) Claims 1-3, 9, 11-12, 14-15, and 18-19 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

7. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heikkila et al. (US 6,428,476 B1) in view of Sham et al. (5,891,042) as applied to claim 1 above, and further in view of Lang (US 2002/0070954 A1).

(A) Claims 4-8 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heikkila et al. (US 6,428,476 B1) in view of Sham et al. (5,891,042) as applied to claims 1 and 9 above, and further in view of Kulkarni (US 2001/0032098 A1).

(A) Claim 10 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

9. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heikkila et al. (US 6,428,476 B1) in view of Sham et al. (5,891,042) as applied to claims 1 and 11 above, and further in view of Richardson et al. (5,976,083).

(A) Claims 16-17 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

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10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heikkila et al. (US 6,428,476 B1) in view of Sham et al. (5,891,042) as applied to claims 1 and 11-12 above, and further in view of Heilman et al. (5,078,134).

(A) Claim 13 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

### ***Response to Arguments***

11. Applicant's arguments filed 8/4/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 8/4/05.

Applicant argues the following:

(1) Applicant argues that Sham does not teach or suggest a "recording means [which] records said exercise motion as valid data only after said identity check means has verified said user's identity," as defined by claim 1.

(A) As per the first argument, the Examiner would like to point out that she did not merely rely on Sham for those features. Rather, the Examiner relied on Heikkila (note page 5 of the Office Action mailed on 3/15/05). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art.  
See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ln  
In  
10-4-05

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600